



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

AUG 9 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

BRUCE STEIN  
INTELLECTUAL PROPERTY LEGAL SERVICES  
PHARAMACIA & UPJOHN COMPANY  
KALAMAZOO MI 49001

*A 20*

In re Application of	:
Arthur G. Romero	:
Serial No.: 09/313,534	: PETITION DECISION
Filed: May 13, 1999	:
Attorney Docket No.: 4830.P-RE	:

This is in response to applicant's renewed petition under 37 CFR 1.144, filed July 9, 2002, requesting reconsideration and withdrawal of an improper restriction requirement.

#### BACKGROUND

A review of the file history is set forth in the previous petition decision and is not repeated herein. The decision granting applicant's previous petition in part was mailed May 3, 2002 and reduced the number of groups of invention to two, the constructively elected patented tricyclic compounds and the newly added bicyclic compounds. Concurrently with the submission of this renewed petition applicant has submitted an amendment adding claim 13 drawn to a bicyclic compound in which variables  $R_3$  and  $R_4$  are shown and then defined as being "joined to form an X-substituted-imidazolin-2-one, CONX, when  $C_3$  is either in the R- or S- configuration". No other options for  $R_3$  and  $R_4$  are given. Thus a tricyclic ring system is claimed although only a bicyclic ring system is shown. The claim would be included within Group I, the elected invention.

#### DISCUSSION

Applicant especially notes that portion of the decision which states that the substituted quinoline compounds are sufficiently different from the patented tricyclic compounds, imidazoquinolines, as to be considered independent and distinct inventions. Applicant now submits an additional amendment after Final rejection (the amendment has not been considered by the examiner) and argues that the newly presented claim provides a link between the two groups of compounds. Applicant bases an argument for addition of such a claim on the statement in the petition decision that had claims 9-11 "been presented in a single application no restriction would have been

possible as they all have the same bicyclic ring system and vary only in their substituents". Said statement remains factual, but does not apply to newly presented claim 13 since it does not describe a bicyclic compound as noted above.

Applicant's argument that both bicyclic and tricyclic ring systems have been allowed in the same patent is immaterial. Each application is examined on its own merits. Restriction between independent and distinct inventions in an application is a tool an examiner may utilize during examination, but its use is not required. Whether the examiner could by searching the bicyclic compounds also find pertinent tricyclic compounds is not an issue here. Applicant prosecuted only tricyclic compounds in the initial application and they constitute a distinct invention. To now add claims to precursor compounds containing different ring structure and substituents would require the examiner to expand the original search concept significantly. In addition, bicyclic quinoline compounds are well known and recognized as separate, independent and distinct compounds as compared to the tricyclic compounds claimed.

#### DECISION

Applicant's renewed petition is **DENIED**.

**The application will be forwarded to the examiner for entry and consideration of applicant's amendment submitted concurrently.**

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



Bruce M. Kisliuk  
Director, Technology Center 1600